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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/004,803	01/09/98	EPPS	J

PM82/0902

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EXAMINER	
STRIMBU,G	
ART UNIT	**PAPER NUMBER**
3634	13

DATE MAILED: 09/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/004,803	Epps et al.
Examiner	**Group Art Unit**
Gregory J. Strimbu	3634

☒ Responsive to communication(s) filed on *Aug 3, 1999* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-5, 7, 9, and 10* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-5, 7, 9, and 10* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on *Jan 9, 1998* is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on *Feb 16, 1999* is ☒approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *10*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on August 3, 1999 have not been approved because the applicant has failed to show the changes in red in accordance with 37 CFR 1.121(3)(ii). The applicant is requested to file a marked-up copy of the drawings showing the corrections in red and a new set of formal drawings incorporating the changes shown in the marked-up copy.

Therefore, the drawings are objected to because throughout the figures several of the lead lines fail to accurately indicate the element of the invention to which a respective reference character refers. For example, see figure 1, wherein the lead line for reference character "31" fails to accurately indicate a fastener. Although the drawings have been indicated as informal, the applicant is reminded that all cross-sectional views and partial sectional views, such as the one shown in figure 1, require proper cross-sectional shading to indicate the material from which the element(s) of the invention are made. See MPEP 608.02. In figure 1, it appears that the portion of the top frame member 19 which is hidden from view by the building wall 10 should be shown with hidden lines to indicate the proper spacial relationship with respect to the building wall 10. In figure 5, the reference characters "16" and "17" each require a lead line indicating the element of the invention to which each of the reference characters respectively refers. Correction is required.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the motor assembly must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Although the examiner agrees that showing the window motor operator assembly is not essential to the understanding of the applicant's invention, it is nonetheless required since the applicant has claimed such a structure. See 37 CFR 1.83(a).

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of figure 5 in view of Boiucaner. The admitted prior art of figure 5 discloses a fast food service window comprising a window assembly with at least one movable window member 16, a window motor operator assembly (not shown, but disposed behind upper frame member 21) mechanically coupled to the movable window member 16, proximity sensor 60

electrically coupled to the motor operator assembly, wherein the movable window member 16 opens whenever a person is sensed by the proximity sensor 60. The movable window member 16 is opened when an infrared beam is detected by an infrared receiver 62 and is closed when the infrared beam is not detected by the infrared receiver 62. The sensor 60 has an integral emitter 61 and receiver 62. The admitted prior art of figure 5 is silent concerning focusing a plurality of sensors upwardly.

However, Boiucaner, in figure 2, discloses a sensor 10 having a plurality of integral infrared emitters 24 and sensors 26. The centerline of the sensor 10 and the centerlines of the emitters 24 and sensors 26 are slightly askew with respect to a vertical axis. The sensor 10 is angled such that it will only operate the door when a person is in a predetermined desired position.

It would have been obvious to one of ordinary skill in the art to position a plurality of sensors of the admitted prior art of figure 5 upwardly to only operate the door when a person is in a desired predetermined position, as taught by Boiucaner, to prevent the door from unexpectedly opening, to conserve energy and to increase the working life of the door.

Response to Arguments

Applicant's declarations filed August 3, 1999 have been fully considered but they are not persuasive.

The applicant contends that the declarations regarding long felt need, commercial success and non-obviousness present sufficient evidence to overcome the rejection of record. However, the declarations are not sufficient to support the applicant's position.

Establishing a long felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. Thus, the need must have been a persistent one that was recognized by those of ordinary skill in the art. The declaration by Cheri Roell contends that because Wendy's International has had a long felt need for a window that opens without generating too many false open and close operations, the problem is recognized in the art and has existed for a long period of time without solution. The declarant's position is untenable. The problems facing Wendy's International, without further evidence, do not represent art recognized problems, they merely represent the problems facing a corporation. In addition, the declarant came to the conclusion that there has been a long felt need without providing evidence of the actual time the need has been recognized. Thus, examiner cannot determine if the declarant's conclusion that there has been a long felt need is indeed accurate. The declaration of Ray J. Epps attempting to establish the presence of a long felt need, in addition to suffering from the same deficiencies as set forth above, merely presents evidence that is tantamount to hearsay. Note paragraphs 9-11 of the declaration which rely on the statements of the customers. If the applicant wishes to present the statements of the "customers", it is suggested that the applicant obtain declarations of the customers themselves rather than relying on a third party, i.e., Mr. Epps.

The declaration of Ray J. Epps attempting to establish commercial success is not persuasive because it fails to sufficiently prove the commercial success of the applicant's invention. The declaration merely points out that the sales of the applicant's previous fast food service window have dropped. It does not attempt to show the sales of the applicant's claimed invention and what percentage of the market those sales represent. Even if the applicant had provided evidence of the sales of the claimed invention, evidence related solely to the number of units sold provides a very weak showing of commercial success. Moreover, if the applicant had sufficiently demonstrated commercial success, that success is relevant in the obviousness context only if it is established that the sales were a direct result of the unique characteristics of the claimed invention, as opposed to other economic and commercial considerations unrelated to the quality of the claimed subject matter.

Finally, the declaration of Steve Halliburton fails to establish non-obviousness. The declarant merely makes a naked conclusion that it would not have been obvious to position the previously outwardly facing sensors upwardly without considering the prior art or the art of record. Thus, the declarant provides no evidence of what the prior art fairly teaches, what inferences can be drawn from the disclosures of the prior art and how one with ordinary skill in the art would evaluate the prior art to determine whether or not it would have been obvious to combine the teachings thereof.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hagenbook, Jonsson, Utke and Gionet et al. are cited for teaching positioning sensors for operating a closure in such a way that only when a person is in a predetermined position will the sensors function to operate a motor to move the closure.

Conclusion

This application is a continuation of applicant's earlier Application No. 09/004,803. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is (703) 305-3979. The examiner can normally be reached on Monday through Friday from 8:00 A.M. to 4:30 P.M. The fax phone number for this Group is (703) 305-3597. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

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